

Application No.: 111667-1000

REISSUE PATENT

#67/ Repl
Brief
2-27-03
L. Sprue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: Davis et al.
Reissue Serial No.: 09/315,796
Filed: May 20, 1999
For: Combined Lithographic/Flexographic Printing Apparatus
and Process
Examiner: Funk, Stephen

Commissioner for Patents
Washington D.C. 20231

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REPLY BRIEF

Appellants hereby submit their Brief in Reply to the Examiner's Answer dated November 20, 2002.

GROUPING OF CLAIMS

The Examiner has asserted that "The rejections of the claims stand or fall together because appellant's Brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." Appellants submit that, to the extent that the Examiner is asserting that all rejections before the Board stand or fall together as a single group, the above statement is a misconstruction of 37 C.F.R. § 1.197(c)(7), which provides as follows:

1.192(c)(7) Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellants' Brief clearly explains, with respect to each ground of rejection, the reasons why that particular ground of rejection is improper and argues the separate patentability of the claims rejected on that ground. Accordingly, Appellants submit that the rejections of the claims do not "stand or fall together," as asserted by the Examiner.

ARGUMENTS

Claims 6, 10, 29, 31, 38, 44-46, and 49 stand rejected under 35 U.S.C. § 102. Claims 6-11, 15-38, 42-57, 60-77, 79-81, and 85-151 stand rejected under 35 U.S.C. § 103(a). As explained in Appellants' Appeal Brief, the Examiner's original rejections failed to establish either anticipation or a prima facie case of obviousness for each rejected claim. The Examiner's Answer failed to address the identified weaknesses, instead merely reiterating the original unsupported rejections, as described in more detail below.

In general, the Examiner has attempted to support his obviousness rejections using a "piecemeal" process wherein specific teachings are culled from various references as needed without any identification of any specific suggestion or motivation to combine the references in the manner suggested by the Examiner. In most cases, one or more of the cited references clearly teaches a process flow opposite to that claimed by Appellants, thereby teaching away from Appellants' claimed invention.

In each case, the Examiner attempts to gloss over the absence of any suggestion or motivation by summarily asserting that the claimed combinations would have been obvious owing merely to the fact that they have been found to be advantageous. Such arguments clearly do not meet the Examiner's clear burden under the law to identify a teaching, suggestion, or motivation to make each asserted combination. The failure on the part of the Examiner to meet his burden has necessitated the present appeal. The Board will note that Appellants have not addressed each of the Examiner's rejections individually in this Reply Brief, as it is believed that Appellants' positions were made clear in the original Appeal Brief. Appellants' arguments below are provided as illustrative examples, and are not exhaustive of the areas in which the Examiner has failed to support his claim rejections, as pointed out in the original Appeal Brief.

The Hartung Declaration

The Examiner has attempted to dismiss and disregard the Hartung declaration on the grounds that it is a merely conclusory declaration, and therefore entitled to no weight. Appellants submit to the Board that the Examiner's handling of the Hartung Declaration is not in conformance with the provisions laid out in M.P.E.P. Chapter 700, and is specifically improper in light of M.P.E.P. § 716.01, which provides that "[w]here the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not

commensurate with the scope of the claims" without an explanation supporting such findings are insufficient." Accordingly, the Hartung Declaration, as objective evidence in the form of the expert testimony of persons of at least ordinary skill in the art, is strong evidence of non-obviousness, which evidence the Examiner has completely failed to counter.

1. **Issue 25: Claims 6, 10, 29, 31, 38, 44-46, and 49 are not anticipated under 35 U.S.C. 102(e) by the Hartung '752 reference.**

In the Examiner's Reply, the Examiner fully conceded that claims 6, 10, 29, 31, 38, 44-46, and 49 are not anticipated by German Gebrauchsmuster 93 05 552.8 to MAN Roland and withdrew the rejections on that ground. The Examiner also conceded that claims 6, 10, 29, 31, 38, 44-46, and 49 are not anticipated by European Patent 620,115 to Hartung et al. ("Hartung '115") and withdrew the rejection on that ground. Appellants strongly agree with the Examiner that these references do not anticipate Appellants' invention as claimed in claims 6, 10, 29, 31, 38, 44-46, and 49.

Curiously, the Examiner has not withdrawn the rejection of claims 6, 10, 29, 31, 38, 44-46, and 49 under 35 U.S.C. § 102(e), instead persisting in this rejection on the ground that it is anticipated by United States Patent No. 5,638,752 to Hartung et al. ("Hartung '752"). Applicant respectfully submits that the Examiner's rejection of claims 6, 10, 29, 31, 38, 44-46, and 49 under 35 U.S.C. § 102(e) is unsupportable for the same reasons as the earlier (now withdrawn) rejections based on anticipation by MAN Roland and Hartung '115.

As an example of the subject matter covered by these claims, Claim 6 reads as follows:

6. Apparatus for a combined lithographic/flexographic printing process comprising:
 - a plurality of successive printing stations for printing color images on a substrate in a continuous in-line process;
 - one of said stations comprising a flexographic printing station printing an aqueous-based vehicle image using the flexographic process to form a metallic coating;
 - a suspended metallic material being included in said aqueous-based vehicle image; and
 - at least one of the successive printing stations comprising an offset lithographic printing station printing a color image over the aqueous-based vehicle image using the offset lithographic process in said continuous in-line process.

The Board will note that the above claim relates to an apparatus "for printing color images" that involves at least one "aqueous-based vehicle image" forming "a metallic coating" and requires "printing a color image over the aqueous-based vehicle image." The Hartung '752 reference does not disclose each and every limitation of claim 6; specifically, it does not recite the printing

of “an aqueous-based vehicle image . . . forming a metallic coating” or “printing a color image over the aqueous-based vehicle image” as required for a finding of anticipation under 35 U.S.C. § 102(e). From the content of the Hartung ‘752 reference, it is clear that Hartung et al. use the term “in-line coating” to define a process clearly distinct from the “printing” of an “image.”

The Board will note that the first portion from the Hartung ‘752 reference cited by the Examiner (col. 2 lines 12-22) does not recite the flexographic printing of an “aqueous-based vehicle image” forming “a metallic coating” or “printing a color image over the aqueous-based vehicle image.” The second cited excerpt (col. 2 lines 38-50) recites “a flexographic printing unit to enable the *in-line coating* of materials printed by the printing unit(s).” (emphasis added) It also recites the use of “metallic-luster” inks, but for “in-line coating” rather than for the printing of images. It certainly does not recite the flexographic printing of an “aqueous-based vehicle image” forming “a metallic coating” or “printing a color image over the aqueous-based vehicle image.”

The third cited excerpt of the Hartung ‘752 reference (col. 5 line 56 – col. 6 line 10) recites the use of flexography for “the application of *basic coatings* prior to printing” and “for applying *intermediate coatings*” (emphasis added), but, again, does not recite the flexographic printing of an “aqueous-based vehicle image” or “printing a color image over the aqueous-based vehicle image.” The case law is clear that, in order to find a claim anticipated by a prior reference, the Examiner must identify *each and every element* of the claim in the reference, and in *as full detail* as recited in the claim.

The Examiner has certainly not established, as he cannot, that the printing of an “aqueous-based vehicle image” is anticipated by the “in-line coating” of the Hartung ‘752 reference. As noted in Appellant’s brief, the Examiner’s rejection on this point is *directly counter* to the declaration of the named inventors themselves as to what *their own disclosure* would teach one of skill in the art. Accordingly, the Examiner’s rejection of claims 6, 10, 29, 31, 38, 44-46, and 49 under 35 U.S.C. § 102(e) must be reversed.

2. Issues 3, 9, 15, and 19 : Appellants’ Claims are patentable over the combination of MAN Roland in view of Pantone and Offsetpraxis.

The Examiner has rejected claims 6-8, 38, and 49-51 as being obvious over the combination of the MAN Roland, Pantone and Offsetpraxis references. As discussed above, it is

agreed and conceded by the Examiner that the MAN Roland reference does not anticipate claims 6, 10, 29, 31, 38, 44-46, and 49. Accordingly, the MAN Roland reference can only be considered to support a finding of obviousness if each and every limitation of the claims can be found in one or more of the references and the Examiner can identify some teaching or suggestion to combine the references in the manner suggested by the Examiner.

With respect to the MAN Roland reference, the Examiner has cited claims 1 and 6 of that reference for the teaching of “an upstream lacquering station configured as a flexographic station (6).” Claims 1 and 6 of the MAN Roland reference read as follows:

1. Einrichtung vorzugsweise in Bogenrotationsdruckmaschinen für mehrfarbigen Offsetdruck zum Beschichten von Bedruckstoffen mit wenigstens zwei Lackiereinheiten, dadurch gekennzeichnet, dass jede Lackiereinheit einen Druckzylinder (8), einen Formzylinder (10) und eine Auftragwalze (11,14) enthält und die entsprechend Bogenlaufrichtung vorgeordnete Lackiereinheit als Flexodruckwerk (6) ausgebildet ist.

6. Einrichtung nach Anspruch 1 und 2, dadurch gekennzeichnet, dass das Flexodruckwerk (6) in einer Offsetdruckmaschine den Druckwerken (1-5) vorgeordnet ist.

Even if it were accepted that the above claims of MAN Roland disclose “an upstream lacquering station configured as a flexographic station (6),” as asserted by the Examiner, the Examiner has not met his burden of identifying each and every limitation in each rejected claim in one or more of the cited references. The Examiner has not established that any of the cited references teach the printing of *images* with the flexographic printing stations. The Examiner has certainly not established that the cited references teach or suggest that a lithographic ink image is printed over a flexographic image in a single in-line process, as claimed by Appellants.

With respect to the Pantone reference, the Examiner has asserted that “Pantone teaches the conventionality of printing/coating, metallic inks upstream of other colors.” Appellant disagrees with the Examiner’s characterization of the teaching of the Pantone reference. The Pantone reference recites only that metallic inks are often printed *before* other colors, and not necessarily “upstream” as asserted by the Examiner.

With respect to the Offsetpraxis reference, it is clear that this reference also describes a very different process from that claimed by Appellants. The Board’s attention is directed to the second paragraph of the translation, which reads in part as follows:

For the end of January, the Druckereigesellschaft Bushe in Dortmund invited to a press conference with the rather plain title “Dialog in Gold.” But the dialogue was anything but plain. It revealed an innovation that will not only give fresh impulses to the offset printing world and secure its market share, but will increase this share in the future. The “Dialog in Gold” deals with a technology, which allows one to implement economical, high quality gold printing with a

brilliance never before achieved using this technique, *right after the multi-color offset printing*, inline in the same processing step. (emphasis added).

Accordingly, at least two facts are established by the above. First, at the time of the publication of the Offsetpraxis reference, the printing of metallic ink with the flexographic process described therein was considered to be an "innovation" in the printing industry. Second, the Offsetpraxis reference clearly teaches that the metallic ink is printed "*after the multi-color offset printing*," rather than *before*, thereby clearly teaching away from the combination claimed by Appellants. Again, as noted in Appellant's brief, the Examiner's rejection on this point is *directly counter* to the declaration of the named inventors of the MAN Roland reference as to what *their own disclosure* would teach or suggest to one of skill in the art. Accordingly, the Examiner has not established a prima facie case of obviousness on the cited references, and the rejections must, therefore, be overruled.

Even if the Board were to disagree with the above and find that the Examiner has met his burden of establishing a *prima facie* case of obviousness, the Board is still faced with the fact that, to the knowledge of the Appellants, the Hartung inventors, or the Examiner, all persons of skill in the art, no one ever combined the references in the manner asserted by the Examiner or described the combination in a printed publication prior to the invention by Appellants. This is despite the presence of the numerous advantages of the present invention that have been identified by the Examiner himself. This is very strong evidence of non-obviousness. Accordingly, the Examiner's rejections cannot stand.

3. **Issues 4, 12, 13, 23, and 28 : Appellants' Claims are patentable over MAN Roland in view of Pantone, Offsetpraxis and Bird.**

The Examiner has rejected a number of claims under 35 U.S.C. § 103(a) as being obvious over the combination of MAN Roland in view of Pantone in view of Offsetpraxis in view of Bird. The Examiner has, however, failed to identify any teaching, suggestion or motivation to one of skill in the art in any of the references to combine the references in the manner described by the Examiner.

The Examiner has failed to identify, for example, any teaching, suggestion, or motivation to provide the apparatus and method of MAN Roland with a plate cylinder mounted flexographic plate and blanket cylinder so as to selectively utilize the unit as a flexographic or lithographic unit. As described above, far from suggesting the combination of the MAN Roland structure

with their own respective teachings, Offsetpraxis reference teaches away from the combination suggested by the Examiner. Yet again, as noted in Appellant's brief, the Examiner's rejection on this point is *directly counter* to the declaration of the named inventors of the MAN Roland reference as to what *their own disclosure* would teach or suggest to one of skill in the art.

With respect to the Bird reference, this reference also teaches a very different process from the invention described and claimed by Appellants. First, the Bird reference clearly describes a coating process, rather than an image printing process (see, e.g., Abstract, col. 2, lines 60-68). Second, the Bird reference clearly teaches that the coating process takes place at the end of the process, after the printing of the lithographic images. (See, e.g., col. 1, lines 31-37 describing the "downstream coating station"; col. 2, lines 60-68 describing coating "over imaged subject matter offset-printed.") The Examiner has identified no teaching or suggestion in the Bird reference in the direction of flexographic printing prior to lithographic printing. To the contrary, the Bird reference teaches, consistently, the use of downstream flexographic processes to coat over lithographic images printed upstream.

In light of the above, the Examiner has clearly failed to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), and the Examiner's rejection should, therefore, be overruled. Further, even if the Board were to disagree with the above and find that the Examiner has met his burden of establishing a *prima facie* case of obviousness, the Board is still faced with the fact that, to the knowledge of the Appellants, the Hartung inventors, or the Examiner, all persons of skill in the art, no one ever combined the references in the manner asserted by the Examiner or described the combination in a printed publication prior to the invention by Appellants. This is despite the presence of the numerous advantages that have been identified by the Examiner himself. Accordingly, the Examiner's rejections cannot stand.

4. Issue 6 : MAN Roland and Satterwhite do not support a finding of obviousness of Appellants' Claims

As discussed above, MAN Roland clearly does not anticipate Appellants' claimed invention with respect to the limitation that the upstream flexographic station prints an image. The Examiner effectively concedes as much with the statement: "Claim 4 of MAN Roland *arguably* discloses a flexographic plate having an image." (emphasis added.) The Board is encouraged to review the content of cited Claim 4 of MAN Roland. Appellant submits that this claim recites only reliefs in a regular grid across the surface of the plate, not an image.

Accordingly, the Examiner would be incorrect to, and therefore does not, positively assert that claim 4 of MAN Roland teaches a flexographic plate having an image.

With respect to the Satterwhite reference, the Examiner has not identified how the single-press mechanism disclosed therein may be adapted to the multi-station printing apparatus of the present invention. First, the Satterwhite reference does not teach a multi-station printing apparatus. Second, it is clear from a review of the very detailed structure of the Satterwhite reference that this structure would have to be significantly modified in order to function in the manner suggested by the Examiner. The Examiner has identified no teaching, suggestion, or motivation to make these numerous and substantial modifications such that they would be obvious to one of skill in the art.

Accordingly, the Examiner's rejections over the MAN Roland reference in view of the Satterwhite reference should be overruled by the Board. Further, even if the Board were to disagree with the above and find that the Examiner has met his burden of establishing a *prima facie* case of obviousness, the Board is still faced with the fact that, to the knowledge of the Appellants, the Hartung inventors, and the Examiner, all persons of skill in the art, no one ever combined the references in the manner asserted by the Examiner or described the combination in a printed publication prior to the invention by Appellants. This is despite the presence of the numerous advantages that have been identified by the Examiner himself. Accordingly, the Examiner's rejections cannot stand.

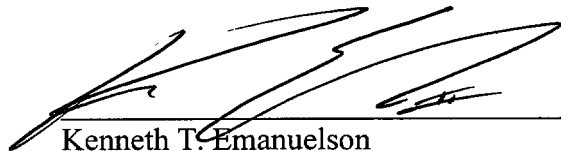
5. Issues 7 and 13 : MAN Roland in view of Satterwhite and Bird

The reasons why it would not have been obvious to combine the MAN Roland reference with the Satterwhite reference and the reasons why it would not have been obvious to combine the MAN Roland reference with the Bird reference apply with even greater force against the Examiner's argument that it would have been obvious to combine all three references. Accordingly, the Examiner's rejection on these grounds must also be reversed. Further, even if the Board were to disagree with the above and find that the Examiner has met his burden of establishing a *prima facie* case of obviousness, the Board is still faced with the fact that, to the knowledge of the Appellants, the Hartung inventors, and the Examiner, all persons of skill in the art, no one ever combined the references in the manner asserted by the Examiner or described the combination in a printed publication prior to the invention by Appellants. This is despite the presence of the numerous advantages that have been identified by the Examiner himself. Accordingly, the Examiner's rejections cannot stand.

CONCLUSION

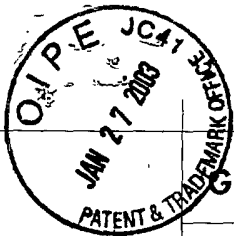
In light of the arguments stated above, Applicants respectfully submit that the Examiner's rejections of claims 6-11, 15-38, and 42-151 are erroneous. As such, Applicants respectfully request that the Board reverse the Examiner's rejections of claims 6-11, 15-38, and 42-151.

Respectfully submitted,



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January 21, 2003

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Commissioner for Patents
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Re: U. S. Patent Application Entitled: "Combined Lithographic/Flexographic Apparatus and Process"
Serial No.: 09/315,796
Filing Date: May 20, 1999
Our File No.: 111667-1000

Dear Sir:

Enclosed for filing please find the following items relating to the above-identified application:

- (1) Reply Brief;
- (2) Request for Oral Hearing;
- (3) Supplemental Information Disclosure Statement;
- (4) PTO-1449 with 1 ref.;
- (5) Checks for \$140 and \$180; and
- (6) Return Postcard.

Please file the above documents and return the date-stamped postcard to our office at the address listed above. If any additional fees are due the Commissioner is authorized to charge Gardere Wynne Sewell LLP's Deposit Account No. 07-0153. In the meantime, if you have any questions or comments concerning this matter, please call the undersigned at your earliest convenience. Otherwise, please accept the enclosed.

Very truly yours,

Kenneth T. Emanuelson
Registration No. 46,684
Enclosures

cc: Jerry Williamson (w/encl.)
Jesse Williamson (w/encl.)
Paul Williamson (w/encl.)

Date of Deposit: <u>1/21/03</u>
I certify that the accompanying paper is being deposited with the United States Postal Service "First Class Mail" service under 37 CFR 1.8 on the date indicated above and is addressed to: Box: Commissioner for Patents, Washington, D.C. 20231.

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